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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,444	11/15/2000	James E. Fergen	28299/34088E	4876

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EXAMINER

ST CYR, DANIEL

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/713,444

Applicant(s)

FERGEN ET AL.

Examiner

Daniel St.Cyr

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 132-152 and 183-212 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 132-152, 183-212 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/9/03 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 132-152 and 183-212 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al, US Patent No. 4,153,931, cited by the applicant in view of Swartz et al, US Patent No. 5,594,228.

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Green et al disclose an automatic library control apparatus comprising: a pair of branch libraries 1 and 2 are shown connected over a plurality of telephone lines TL to a central site 3 housing the central control units. The local library branch 1 comprises a Check-In/Check-Out console 4, a Check-Out console 5, and an alpha-numeric input and output display unit 6; a branch controller 14 or 16 is used to code the input and output data and interfaces the I/O units to the computer; a modem 17 such as the Intertel Model 235, is provided to convert the digital data from the branch controller to an analog signal which is transmitted over the telephone lines TL; a second modem 18 is used at the central receiving site, the central site 3 includes a central processing unit 20, a communications controller 22, and modem 18, a line printer 23, and a series of on-line data files 24 and off-line files 25; an on-line files consist of a circulation file 31 which contains the patron identification number and the item number together with the date of the transaction, an overdue file 32 which contains the overdue item number and the number of overdue days, a reverse file 33 containing the reverse item number and the corresponding patron number, and expired file 34 which stores the expired patron's number together with the number of days the card has expired, a delinquent file 35 which contains the delinquent patron number and the amount owed by the delinquent account, and an auxiliary file 36 which is used for temporary data storage. The off-line files 25 comprise: a patron file 40 which contains the patron number and the name and address of the patron together with any fine accumulated from the overdue files of from returning damaged books, a statistical file 41 which stores the number of patrons and the total fines collected and may also be used for specialized statistical information needs, and an item file 42 which contains a complete inventory of items in the library system (see col. 4, line 15+; figures 1-4).

Green et al fails to disclose or fairly suggest the type payment accepted by the terminal (i.e. credit, debit, smart cards).

Swartz et al disclose a self-checkout point-of-transactions system including deactivatable electro-optically coded surveillance tags comprising: a card reader 170 for reading credit/smart/debit card 174 and suggest that the system could be applied in rental agency or library (see col. 11, lines 56-59).

In view of Swartz et al's teachings, it would have been obvious for a person of ordinary skill in the art at the time the invention was made to modify the system of Green et al by incorporating a card reader to allow patrons to pay for their transactions using credit, debit, and smart cards. Such modification would make the system more practical and would make the system more effective by reducing peak waiting times and would free up counter staffs to concentrate on other library works. Therefore, it would have been an obvious extension as taught by Green et al.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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6. Claims 132-152 and 183-212 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,369,709 (hereinafter '709 Patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is somehow a broader recitation of the '709 patent. For instance, in claim 132 of the present claimed invention and '709 Patent, the applicants claim:

i)"A self-service library terminal comprising: . . . a payment apparatus arranged to received payment from a borrower; . . . wherein the controller is arranged to interact with the payment apparatus in order to process financial transactions related to the library loans transactions, and wherein the controller is arranged to remind the borrower of the borrower's account status". Whereas in '709 Patent, the applicants claim:

ii)"A self-service library terminal comprising: . . . a controller coupled to the code reader, wherein the controller is arranged to process signals from the code reader and to provide an explicit feedback to a borrower when an article has an improper position on the article receiving area, wherein a circulating item has first and second codes thereon, and wherein the controller is arranged to direct a user to place the first code in a reference position where the first code can be read by the code reader if the controller determines that a user has placed the second code in the reference position, wherein the controller is arranged to process financial credit transactions related to the library loan transactions and to remind a borrower of the borrower's account status".

As to the claims 132-152 and 183-212 of the instant application, the '709 Patent meets all the limitation as set forth in claims 1-23.

Thus, in respect to above discussions, it would have been obvious to an artisan at the time the invention was made to use the teaching of claims 1-23 of '709 patent as a general teaching for library books circulation, to perform the same function as claimed in the present invention. The instant claims obviously encompass the claimed invention of the '709 patent and differ only in terminology. The extent that the instant claims are broaden and therefore generic to claimed invention of '709 patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from the claims in a first patent. IN re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. & 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. & 1.78(d).

Response to Arguments

7. Applicant's arguments with respect to claims 132-152 and 183-209 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

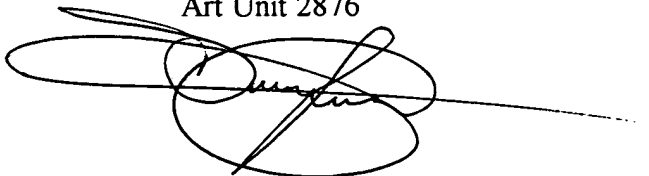
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 703-305-2656. The examiner can normally be reached on Mon-Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7721 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Daniel St.Cyr
Primary Examiner
Art Unit 2876

A handwritten signature in black ink, appearing to read 'Daniel St.Cyr', is written over the printed name and title. The signature is stylized with loops and a long horizontal stroke extending to the right.

DS
July 14, 2003